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In re Application of :
COUSINEAU *et al* :
U.S. Application No.: 10/541,620 :
PCT No.: PCT/CA04/00041 :
Int. Filing Date: 09 January 2004 :
Priority Date: 09 January 2003 :
Attorney Docket No.: 39320.002 :
For: DISTRIBUTED SYSTEM ENABLING :
INTEGRATION AND AUTOMATION OF :
MARKETING SALES AND SERVICES :
:

DECISION

This decision is in response to applicants' "Petition Under 37 CFR §1.47(a)" filed 04 August 2006.

BACKGROUND

On 04 January 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 04 August 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration signed by eight of the nine named inventors; a five-month extension and fee; the petition fee; a declaration of John Cousineau; a supplemental declaration of John Cousineau; a declaration of Kerrie L. Manderscheid; and various exhibits and other documentary evidence.

DISCUSSION

Name of Inventor Misidentified

Petitioners claim that the name of the nonsigning inventor is misidentified as "JOHNSON" on the original application papers and the declaration. The proper spelling of the surname is "JOHNSTON." Section 605.04(b) of the MPEP discusses this situation and states, in part:

When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a

petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. However, applicants are strongly encouraged to use an application data sheet such that any patent to issue will reflect the correct spelling of the inventor's name. Without an application data sheet with the corrected spelling, any patent to issue is less likely to reflect the correct spelling since the spelling of the inventor's name is taken from the oath or declaration, or any subsequently filed application data sheet.

Petition Under 37 CFR 1.47(a)

Applicants claim that co-inventor, Michael Johnston, refuses to join the subject application and have filed the subject petition. A five-month extension fee has been paid. A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors. Items (1), (3) and (4) are complete.

Concerning item (1), the petition fee has been charged to counsel's Deposit Account.

Regarding item (2), applicants' burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP. Several pertinent segments are listed below:

A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. . . . When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

In this case, petitioners have submitted evidence showing that after a diligent effort in locating the nonsigning inventor, a copy of the application papers and declaration were sent to Mr. Johnston via email on 20 February 2006 and opened on 25 February 2006. Another email with personalized instructions was sent on 16 June 2006. However, there was no evidence this email was opened. On 06 July 2006, a package was delivered to Mr. Johnston at his last known address containing a copy of all previous letters and the filed application using TNT Couriers. These documents were never able to be delivered. Petitioners also submitted documentary evidence verifying the declarations of facts provided.

A review of the evidence demonstrates that the conduct of Mr. Johnston constitutes a refusal to cooperate pursuant to section 409.03(d) of the MPEP. Mr. Johnston has not responded to repeated requests to sign the application papers. There is evidence that the papers were received via email on 25 February 2006. See Exhibit E. In addition, petitioners attempted to deliver a complete copy of the application and papers but were unable to deliver them. These efforts are sufficient to satisfy item (2).

With regards to item (3), the last known address of co-inventor Michael Johnston is listed in the petition as:

Kalkarer Strasse 2,
40547, Dusseldorf,
Germany

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by eight of the nine joint inventors on behalf of both nonsigning joint inventor.

However, this declaration does not comply with 37 CFR 1.497(a) and (b). The declaration submitted is only a composite declaration consisting of one Page 1, one Page 2, three Page 3, and two Page 4. This is not acceptable. Applicants must submit a complete copy of each declaration signed by each inventor and the declaration must identify the correct inventive entity. For this reason, item (4) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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